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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/784,680

02/23/2004

John Tilby

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EXAMINER

CLEMENT, MICHELLE RENEE

ART UNIT

PAPER NUMBER

3641

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/21/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/784,680	TILBY, JOHN	
	Examiner	Art Unit	
	Michelle (Shelley) Clement	3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,9 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,9 and 20-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/2/06 have been fully considered but they are not persuasive. With regards to new claims 21-26, applicant's general contention that the amendments define over the Jenkins reference are not persuasive in that the amendments merely add functional language and language directed toward the intended use of the device rather than structurally define between the current invention and that of the prior art. Applicant has merely attempted to define the size of the annular opening based on a diameter of a magazine tube and has neither positively recited the magazine tube nor positively limited the size of the annular opening in that it is well known that magazine tubes are a wide variety of sizes and applicant has not stated in either the specification nor in the claims that the annular opening is a set size but merely tries to define it by some unknown ambiguous, unclaimed and undefined magazine tube. The device of Jenkin has an annular opening with a diameter less than an outside diameter of a least one magazine tube in the world. With regards to claim 1 however, applicant's amendments make these arguments moot and necessitate new grounds of rejection. In regards to claim 20 however, applicant's arguments do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. It has been held that the recitation that an element is "adapted to" or "configured to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Drawings

2. The drawings were received on 10/2/06. These drawings are not acceptable. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figures 3, 5A, 5B and 6 are not of sufficient quality and are too dark to examine. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 2, 5-6, 9, 21, 26 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The grommet having annular opening with a diameter less than an outside diameter of a magazine tube and the grommet including a cutout relief such that **NO** part of the sling adaptor contacts a barrel of a shotgun was not described in the specification at the time the

Art Unit: 3641

application was filed. Specifically the application discloses “[the annular opening] may be configured with a diameter *of about* the external diameter of a shotgun magazine tube, but less than the diameter of most magazine tube end caps” (emphasis added ¶ 0020); “the fit of the annular opening in the grommet having size about diameter of about the external diameter of a shotgun magazine barrel or tube may be a snug fit or a sliding fit” (¶ 0020, p. 9); and “the grommet can slightly stretch if needed to fit over larger magazine tubes while preventing itself from being stretched over the magazine end cap when used on smaller diameter magazine tubes” (¶ 0020, p.9). This final sentence displays that 1) magazine tubes have various diameters and 2) applicant does not disclose a grommet having an annular opening with a diameter **less than** an outside diameter of **ALL** magazine tubes as applicant is currently claiming. (It is noted that applicant’s amendment has necessitated this new grounds of rejection in that new claim 1 is different than previous claim 3 incorporating the limitations of claim 1 in that applicant did not include ALL of the language of claim 3 into claim 1 thus necessitating this new ground of rejection.)

5. Claims 1-3, 5-6, 9 and 21 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a grommet having an annular opening and a sling connector, does not reasonably provide enablement for a grommet having an annular opening with a diameter less than an outside diameter of a magazine tube, since it is known for magazine tubes to have a wide variety of outside diameters and applicant has disclosed the annular opening having a diameter about the same size and larger than some magazine tubes. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly

Art Unit: 3641

connected, to make and/or use the invention commensurate in scope with these claims (See ¶ above).

6. Claims 26 and 27 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the grommet including a cutout relief, does not reasonably provide enablement for the cutout relief such that NO part of the sling adaptor contacts a barrel of the shotgun upon installation. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The specification does is not enabling for the cutout relief provided as claimed, applicant states at ¶ 0022 that the adaptor may include a cutout relief to clear the barrel of a shotgun or to at least reduce the amount of resiliently elastic material of the grommet between a shotgun barrel and a magazine tube. Since applicant has neither disclosed nor claimed a specific shotgun and it is well known that many shotguns exist, each one having a different clearance, applicant has not disclosed the grommet being capable of having NO part of the adaptor contacting the barrel of ALL shotguns and it is not clear how one would make such a single adaptor since many shotguns are custom and their dimensions are not even known.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 1-3, 5-6, 9 and 20-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the grommet having an annular opening “which receives an end of a magazine tube of a shotgun”, it is not clear to the examiner if

Art Unit: 3641

applicant is attempting to claim the adaptor in combination with the magazine tube or is merely stating the intended use of the adaptor is merely attempting to define the size of the opening based on an object that is outside the scope of the claims in which case applicant is merely stating that the structure has *the ability to* perform such function. Claim 21 similarly recites "to fit over the magazine tube", it is not clear whether applicant intends the adaptor in combination with the magazine tube or merely the structure having *the ability to* perform the function. Claim 20 recites the limitation "the forend of a magazine tube". There is insufficient antecedent basis for this limitation in the claim in that applicant has not previously claimed a magazine tube, or the forend of the tube, and it is not clear whether applicant is trying to positively claim the forend of the magazine tube or is merely claiming an intended function of the device.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 5, 6, 9 and 20-25 rejected under 35 U.S.C. 102(b) as being anticipated by Arnold (US Patent # 5,573,152). Arnold discloses a device comprising a grommet (reference 12) formed of high density polyethylene (i.e. a relatively thin (1/16 of an inch), resiliently elastic material; i.e. plastic) having an annular opening (reference 14) with a diameter less than an outside diameter of a magazine tube (Arnold discloses the opening as 15/16 of an inch, which is less than an outside diameter of some known magazine tubes) and having a size that could be held relative to a magazine tube by a stock magazine cap and a sling connector (reference 10)

Art Unit: 3641

having *the ability to* attach to the grommet (i.e. configured for attachment to the grommet), wherein the connector has *the ability to* couple an end of a gun sling to the grommet (i.e. is configured to perform the stated function). The thickness of the grommet (i.e. 1/16 of an inch) would allow the attachment of a stock magazine cap to a magazine tube with the grommet held thereinbetween. The annular opening includes radial scoring (reference 26) to effectively increase the annular opening diameter. The both the grommet and the connector are made of a plastic material, and the connector comprises a plastic ring (Figure 4). The connector is attached to the grommet by a loop of the grommet material (reference 20). It is noted that it has been held that the recitations that an element is "adapted to" ("configured for", "configured to", "sized to" and "sized for") perform a function is not a positive limitation but only requires the ability to achieve a degrees of the stated function. It does not constitute a limitation in any patentable sense as long as the structure of the prior has the ability to achieve to at least some degree the claimed function. *In re Hutchison*, 69 USPQ 138. Furthermore it is noted that the [a)statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Art Unit: 3641

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

11. Claims 20 and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Jenkin (US Patent # 5,303,859). Jenkin discloses a shotgun sling mounting apparatus comprising a grommet and a sling connector. The grommet formed of a relatively thin, flexible material (it is noted that Jenkin discloses that the grommet can be formed of any suitable material and the term “flexible” is a relative term in that any material has a certain amount of flexibility). Furthermore the term “relatively thin” is a relative term that is not defined by the claims or the specification and therefore does not patentably distinguish between the current claims and that of the previous art). The grommet *has the ability to* be held directly against a forend of a magazine tube by a stock magazine cap and having an annular opening that has the ability to receive an end of a magazine tube of a shotgun (i.e. configured to and sized to perform the stated functions). The sling connector having the ability to be attached to the grommet and having the ability to couple an end of a gun sling to the grommet (i.e. configured to perform the stated functions). The sling connector is made of any suitable material and the sling connector is attached to the grommet by a loop of the grommet material (reference 23).

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkin as applied to claim 1 above. Jenkin discloses the claimed invention except for the specific material for the grommet and sling connector. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use rubber for the grommet and a metal ring for the sling connector, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

14. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jenkin as applied to claim 20 above, and further in view of McKinzie (US Patent # 3,715,827). Although Jenkin does not expressly disclose the grommet including a cutout relief, McKinzie does. McKinzie teaches a magazine tube sling adaptor comprising a grommet and a sling connector. The grommet including a cutout relief (reference 24). McKinzie and Jenkin are analogous art because they are from the same field of endeavor: firearm sling adaptors. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cutout relief as suggested by McKinzie with the device as disclosed by Jenkin. The

Art Unit: 3641

suggestion/motivation for doing so would have been to obtain a magazine tube device that had clearance for the barrel as suggested by McKinzie at column 2.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3641

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


MICHELLE CLEMENT
PRIMARY EXAMINER